



THELEN REID BROWN

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RAYSMAN & STEINER L.L.P
P.O. BOX 640640
SAN JOSE CA 95164-0640

In re Application of
Grant et al.
Application No.: 10/538,160
PCT No.: PCT/US03/38899
Int. Filing Date: 08 December 2003
Priority Date: 08 December 2002
Attorney Docket No.:IMMR-0152A (034701-000510)
For: Methods And Systems For Providing Haptic
Messaging To Handheld Communication Devices

DECISION

This is in response to the renewed submission under 37 CFR 1.497(d) filed on 05 March 2007, and the declaration of inventorship filed on 19 March 2007.

DISCUSSION

In a Decision mailed on 02 October 2006, the declaration of the inventors filed on 27 June 2006 was not accepted under 37 CFR 1.497(d), without prejudice, because

Regarding requirement (3), the “Consent of Assignee” document included among the instant correspondence is signed on behalf of Immersion Corporation by Laura Peter in the capacity of “Vice President and General Counsel,” and who further states that she is “authorized to execute this Consent of Assignee.” The “Consent of Assignee” is accompanied by a “Statement Under 37 CFR 3.73(b),” also signed by Ms. Peter, which asserts that Immersion Corporation is “the assignee of the entire right, title and interest” in this application. The “Statement...” references attached “copies of assignments or other documents in the chain of title.” A copy of an assignment document has provided; however, the assignment is accompanied by neither an instruction to record the assignment nor by a statement specifying where documentary evidence of a chain of title is recorded in the assignment records of the USPTO (e.g., reel and frame number). As such, applicants have failed to comply with 37 CFR 3.73(b). Therefore, requirement (3) has not been satisfied.

Inspection of the declaration filed on 27 June 2006 reveals that it appears to have been assembled by aggregating individual sheets signed by each of the inventors into a single document. Since counsel has not provided copies of the complete declaration documents signed by each inventor, it is not clear that each inventor had the benefit of signing a complete copy of the declaration document. Moreover, the declaration includes an uninitialed alteration to Mr. Shahoian’s name. Therefore, it would not be appropriate to grant the requested relief at this time.

In response, counsel has identified the Reel and Frame numbers where the assignment has been recorded in the records of the USPTO. Counsel's attention is directed to MPEP 324, which states in part that

II. ESTABLISHING OWNERSHIP

When an assignee first seeks to take action in a matter before the Office with respect to a patent application, patent, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Director. 37 CFR 3.73(b). The assignee's ownership may be established under 37 CFR 3.73(b) by submitting to the Office, in the Office file related to the matter in which action is sought to be taken:

(A) documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment submitted for recording) >and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is, submitted for recordation pursuant to 37 CFR 3.11<; or

(B) a statement specifying, by reel and frame number, where such evidence is recorded in the Office.

*Documents submitted to establish ownership **>are< required to be recorded>, or submitted for recordation pursuant to 37 CFR 3.11, < as a condition to permitting the assignee to take action in a matter pending before the Office.*

The action taken by the assignee, and the 37 CFR 3.73(b) submission establishing that the assignee is the appropriate assignee to take such action, can be combined in one paper.

The establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted. 37 CFR 3.73(c). If the submission establishing ownership is not present, the action sought to be taken will not be given effect. If the submission establishing ownership is submitted at a later date, that date will be the date of the request for action or the date of the assignee's action taken.

The submission establishing ownership by the assignee must be signed by a party who is authorized to act on behalf of the assignee. See discussion below. Once 37 CFR 3.73(b) is complied with by an assignee, that assignee may continue to take action in that application, patent, or reexamination proceeding without filing a 37 CFR 3.73(b) submission each time, provided that ownership has not changed.

The submission establishing ownership by the assignee pursuant to 37 CFR 3.73(b) is generally referred to as the "statement under 37 CFR 3.73(b)" or the "37 CFR 3.73(b) statement." A duplicate copy of the 37 CFR 3.73(b) statement is not required and should not be submitted. See 37 CFR 1.4(b) and MPEP § 502.04.

In the instant case, the submission establishing ownership has not been "signed by a party who is authorized to act on behalf of the assignee" in that the reference to the Reel/Frame numbers has not been signed by an individual whose authority to sign on behalf of assignee has been established. As further explained at MPEP 324,

(A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. 37 CFR 3.73(b)(2)(ii). An officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales,

executive vice-president, assistant treasurer, vice-chairman of the board of directors. In foreign countries, a person who holds the title "Manager" or "Director" is normally an officer and is presumed to have the authority to sign on behalf of the organization. A person having a title (administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee. A power of attorney (37 CFR 1.32(b)(4)) to a patent practitioner to prosecute a patent application executed by the applicant or the assignee of the entire interest does not make that practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee.

(B) The submission may be signed by any person, if the submission sets forth that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e., to sign the submission on behalf of the assignee. 37 CFR 3.73(b)(2)(i).

(C) The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the submission on behalf of the assignee, if a copy of the resolution is, or was previously, submitted in the record.

Therefore, the assignee's ownership has not yet been adequately established under 37 CFR 3.73(b). As such, it would not be appropriate to grant the requested relief at this time. An appropriate response would be a reference to the Reel/Frame numbers signed by an individual whose authority to sign on behalf of assignee has been properly established pursuant to (A), (B) or (C) above.

Inspection of the declaration documents submitted on 05 March 2007 and 19 March 2007 reveals that, taken together, they satisfy the requirements of 37 CFR 1.497(a) and (b).

CONCLUSION

The declaration is **NOT ACCEPTED** under 37 CFR 1.497(d), without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT** of this application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.497(d)". No additional processing fee is required.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459